

ESTTA Tracking number: **ESTTA794147**Filing date: **01/10/2017**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|--|-------------|----------|
| Name | PPG Industries Ohio, Inc. | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 3800 West 143rd Street Cleveland, OH 44111 UNITED STATES | | |

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|----------------------|--|
| Attorney information | Dennis S. Prah Ladas & Parry LLP 1040 Avenue of the Americas New York, NY 10018-3738 UNITED STATES dprahl@ladas.com,jkelly@ladas.com,jkwon@ladas.com,rroa@ladas.com |
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Registration Subject to Cancellation

| | | | |
|-----------------|--|-------------------|------------|
| Registration No | 4262308 | Registration date | 12/18/2012 |
| Registrant | AmeriCoats 3429 N. Runge Street Franklin Park, IL 60131 UNITED STATES | | |

Goods/Services Subject to Cancellation

Class 002. First Use: 2012/05/01 First Use In Commerce: 2012/05/01

All goods and services in the class are cancelled, namely: Powder coatings in the nature of a clear finish used to coat aluminum extrusions to prevent scratching, chipping, staining or otherwise being damaged by heat or other elements

Grounds for Cancellation

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|--------------------------------------|---------------------------------------|
| Priority and likelihood of confusion | Trademark Act Sections 14(1) and 2(d) |
| Other | Family of Trademarks |

Marks Cited by Petitioner as Basis for Cancellation


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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3012577 | Application Date | 02/03/2004 |
| Registration Date | 11/08/2005 | Foreign Priority Date | NONE |
| Word Mark | AMERSHIELD | | |

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| Design Mark | AMERSHIELD |
| Description of Mark | NONE |
| Goods/Services | Class 002. First use: First Use: 1986/10/01 First Use In Commerce: 1986/10/01 PROTECTIVE COATINGS IN THE NATURE OF PAINT |

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|----------------------|--|-----------------------|------------|
| U.S. Application No. | 86765781 | Application Date | 09/23/2015 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | AMERSHIELD | | |
| Design Mark | AMERSHIELD | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 002. First use: First Use: 1986/10/01 First Use In Commerce: 1986/10/01 PROTECTIVE COATINGS IN THE NATURE OF PAINT | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 927685 | Application Date | 09/25/1970 |
| Registration Date | 01/25/1972 | Foreign Priority Date | NONE |
| Word Mark | AMERCOAT | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 002. First use: First Use: 1936/01/00 First Use In Commerce: 1936/01/00 PROTECTIVE COATINGS IN THE NATURE OF A PAINT-NAMELY, VINYL-, EPOXY-, COAL TAR-,ACRYLIC-, AND ALKYD-BASED COATINGS AND ZINC-RICH ORGANIC AND INORGANIC COATINGSUSED IN COATING STEEL OR OTHER METALS TO PREVENT CORROSION AND AS TANK LININGS TO PREVENT ATTACK AND/OR CONTAMINATION AND AS A PROTECTIVE COATING FOR CONCRETE AND IN NUCLEAR ENVIRONMENTS WHERE RADIATION AND DECONTAMINABILITY ARE FACTORS | | |

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|-----------------------|---------|------------------|------------|
| U.S. Registration No. | 1842591 | Application Date | 04/01/1993 |
|-----------------------|---------|------------------|------------|

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|---------------------|---|-----------------------|------|
| Registration Date | 07/05/1994 | Foreign Priority Date | NONE |
| Word Mark | AMERTHANE | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 002. First use: First Use: 1980/08/31 First Use In Commerce: 1980/12/31 polyester-urethane coatings for cars and trucks | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1256503 | Application Date | 09/09/1982 |
| Registration Date | 11/08/1983 | Foreign Priority Date | NONE |
| Word Mark | AMERLOCK | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 002. First use: First Use: 1982/03/00 First Use In Commerce: 1982/03/00 Protective Coating Used Primarily on Steel Surfaces to Protect Against Corrosion | | |

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|-------------|---|
| Attachments | 76573763#TMSN.png(bytes) 86765781#TMSN.png(bytes) 74374136#TMSN.png(bytes) Petition for Cancellation - AmeriCoats.pdf(512059 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|------------------|
| Signature | /Dennis S. Prah/ |
| Name | Dennis S. Prah |
| Date | 01/10/2017 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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| PPG INDUSTRIES OHIO, INC., | : | |
| | : | |
| Petitioner, | : | Cancellation No. _____ |
| | : | |
| v. | : | Registration No. 4,262,308 |
| | : | |
| AMERICOATS, | : | |
| | : | |
| Respondent. | : | |
| | : | |
| | X | |

PETITION FOR CANCELLATION

In the matter of AMERISHIELD Registration No. 4,262,308, owned by AmeriCoats, a Corporation organized under the laws of Illinois, having an address at 3429 N. Runge Street, Franklin Park, Illinois 60131 (“Respondent”), covering “Powder coatings in the nature of a clear finish used to coat aluminum extrusions to prevent scratching, chipping, staining or otherwise being damaged by heat or other elements” in International Class 2, on the Principal Register (“Respondent’s Goods”), which registration issued on December 18, 2012;

PPG Industries Ohio, Inc., a Corporation organized under the laws of Delaware, having an address at 3800 West 143rd Street, Cleveland, Ohio 44111 (“Petitioner”), believes that it is or will be damaged by AMERISHIELD Registration No. 4,262,308 and hereby petitions to cancel said registration on the following grounds:

I.

Section 2(d) Likelihood of Confusion

1. Petitioner is the owner of the well-known mark AMERSHIELD for “protective coatings in the nature of paint” in International Class 2, which mark has been continuously used in commerce since at least as early as October 1, 1986 (“Petitioner’s AMERSHIELD Mark”).

2. Petitioner’s AMERSHIELD Registration No. 3,012,577 for “protective coatings in the nature of paint” in International Class 2, which registration issued on November 8, 2005, and claimed first use in commerce at least as early as October 1, 1986, was inadvertently allowed to lapse and was cancelled on September 21, 2012.

3. On September 23, 2016, Petitioner filed AMERSHIELD Application Serial No. 86/765,781 for “protective coatings in the nature of paint” in International Class 2, claiming first use in commerce at least as early as October 1, 1986 (“Petitioner’s AMERSHIELD Application”).

4. In the intervening period, Respondent’s AMERISHIELD Mark, which application was filed on September 26, 2011, issued to registration on December 18, 2012, as Registration No. 4,262,308 for “Powder coatings in the nature of a clear finish used to coat aluminum extrusions to prevent scratching, chipping, staining or otherwise being damaged by heat or other elements” in International Class 2, claiming first use in commerce on May 1, 2012 (“Respondent’s AMERISHIELD Mark”).

5. Petitioner adopted and has continuously used Petitioner’s AMERSHIELD Mark in commerce in connection with “protective coatings in the nature of paint” since at least as early as October 1, 1986, long before the filing date and claimed date of first use in commerce of

Respondent's AMERISHIELD Mark. Petitioner has priority of use and precedes Respondent's claimed first use of AMERISHIELD in commerce by more than two decades.

6. Petitioner has extensively advertised, promoted, marketed, and sold goods under its AMERSHIELD Mark such that consumers have come to know and recognize Petitioner's AMERSHIELD Mark as identifying goods that originate with, are authorized by or otherwise identify Petitioner.

7. On or about January 6, 2016, the USPTO issued an Office Action refusing Petitioner's AMERSHIELD Application based on § 2(d) likelihood of confusion grounds with Respondent's AMERISHIELD Registration No. 4,262,308. Petitioner submitted written arguments in response to the Office Action on July 5, 2016. The USPTO maintained its refusal, which was made final on July 11, 2016.

8. Petitioner will be harmed by the continued registration of Respondent's AMERISHIELD Mark at least because the USPTO Examiner issued a §2(d) refusal against Petitioner's AMERSHIELD Application citing Respondent's AMERISHIELD Registration No. 4,262,308 as a bar to registration.

9. Additionally, if Respondent's AMERISHIELD Mark is permitted to remain on the Principal Register, said registration may suggest that Respondent has exclusive rights to use such mark in commerce, and Respondent may assert same against Petitioner and prevent or otherwise impair Petitioner's exclusive rights to use Petitioner's AMERSHIELD mark.

10. Respondent's registration of AMERISHIELD Registration No. 4,262,308 in connection with Respondent's Goods so resembles Petitioner's prior AMERSHIELD Mark as to be likely to cause confusion, or to cause mistake, or to deceive, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

II

Family of Trademarks – Likelihood of Confusion

11. Petitioner respectfully repeats and re-alleges each and every allegation set forth at ¶¶ 1-10 above, as if fully set forth at length herein.

12. In addition to its long-standing use of AMERSHIELD, Petitioner adopted and has continuously and extensively used a variety of well-known AMER-formative marks, including without limitation the following incontestable registered marks:

| Mark | Reg. No. Filing Date Reg. Date | Goods | Date of First Use in Commerce (Date of First Use Anywhere) |
|------------------|---|--|---|
| AMERCOAT | Reg. No. 927,685 Filed Sept. 25, 1980 Reg. Jan. 25, 1972 | “Protective coatings in the nature of a paint-namely, vinyl-, epoxy, coal tar-, acrylic-, and alkyd-based coatings and zinc-rich organic and inorganic coatings used in coating steel or other metals to prevent corrosion and as tank linings to prevent attack and/or contamination and as a protective coating for concrete and in nuclear environments where radiation and decontaminability are factors” in International Class 2 | January 1936 (January 1936) |
| AMERTHANE | Reg. No. 1,842,591 Filed April 1, 1993 Reg. July 5, 1994 | “Polyester-urethane coatings for cars and trucks” in International Class 2 | December 31, 1980 (August 31, 1980) |
| AMERLOCK | Reg. No. 1,256,503 Filed Sept. 9, 1982 Reg. Nov. 8, 1983 | “Protective Coating Used Primarily on Steel Surfaces to Protect Against Corrosion” in International Class 2 | March 1982 (March 1982) |

13. Since long before the filing date and claimed date of first use in commerce of Respondent’s AMERISHIELD Mark, Petitioner has used its various AMER-formative marks together as a “family of trademarks.” Through Petitioner’s significant marketing, advertising,

sales and use, consumers have come to recognize Petitioner's AMER-formative marks as a "family of trademarks" indicative of a unitary source of origin.

14. Respondent's registration of AMERISHIELD Registration No. 4,262,308 in connection with Respondent's Goods so resembles Petitioner's prior family of AMER-formative trademarks as to be likely to cause confusion, or to cause mistake, or to deceive, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

15. Petitioner pleads a "family of trademarks" both in addition to and as an alternative to the ground set forth at I above, as provided for under Fed. R. Civ. P. Rule 8(d).

WHEREFORE, Petitioner requests that this Petition for Cancellation be sustained and that AMERISHIELD Registration No. 4,262,308 be cancelled.

Respectfully submitted,

LADAS & PARRY LLP
Attorneys for Petitioner

Dated: January 10, 2017

By: 

Dennis S. Prah
John W. Kelly
Jennifer Kwon
1040 Avenue of the Americas
New York, New York 10018
(212) 708-1800
(Our Ref: C16676161)

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **PETITION FOR CANCELLATION** has been transmitted electronically to the United States Patent and Trademark Office on the date indicated:

Dated: January 10, 2017


Reinaldo Roa

CERTIFICATE OF SERVICE


I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **PETITION FOR CANCELLATION** was served via First Class Mail, on the date indicated below, to the following:

AmeriCoats
3429 N. Runge Street
Franklin Park, Illinois 60131

Vandana Balakrishnan
Raj Abhyanker, P.C.
1580 W El Camino Real, Ste. 8
Mountain View, California 94040-2462

Phone: 650-965-8731
Email: trademarks@rajpatent.com

Dated: January 10, 2017


Reinaldo Roa